

Applicants: Swarn S. Kalsi, et al.  
Serial No.: 10/083,927  
Filed: February 27, 2002  
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Attorney's Docket No.: 05770-170001  
Client Ref. No.: AMSC-546

### REMARKS

Claims 1-19, and 30-36 are pending.

The Applicant thanks the Examiner for the August 31, 2005 interview and acknowledges receipt of the Interview Summary.

The Examiner rejected independent claims 1 and 30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,356,419 to Boer and U.S. Patent No. 4,330,726 to Albright.

As Examiner knows, and as stated in MPEP 2143:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (emphasis added).

Additionally, as stated in MPEP 2143.01:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

...

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Boer describes an apparatus for fastening an air gap winding for electric machines having a large power rating (Abstract). As the Examiner admitted in the July 20, 2005, Office Action, Boer's apparatus includes a lamination stack 20 that comprises tooth-shaped segment parts 202 formed from non-magnetic material, and segment parts 201, without teeth, formed from a magnetic material (Boer's FIG. 2, col. 2, lines 5-8, and col. 4, lines 21-32). With reference to this specific construction, Boer explains:

Through this construction, the stator lamination stack and the mounting body are combined to form a single component, which meets all requirements regarding controlling the tangentially attacking forces and ensures a short-circuit proof connection of the air gap winding to the shielding package. The lamination segments fabricated by welding from different segment parts have approximately the same mechanical strength as a homogeneous lamination segment and are

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divided, due to the magnetic properties, into a magnetic shielding zone and a non-magnetic holding zone, (Boer's col. 2, lines 18-28)

Thus, Boer's specific construction requires that there be a magnetic shielding zone (provided through the magnetic segment portions 201) and a non-magnetic shielding zone (provided through the tooth-shaped portions 202).

Albright, on the other hand, describes a stator that comprises a stack of modular sections, each comprising an outer cylinder and an inner cylinder. As shown in Albright's FIG. 1, Albright's inner cylinder 14, which includes teeth portions and a surrounding ring, is constructed from a non-metallic material (Albright, col. 4, lines 25-26). Thus, because Albright's entire inner cylinder 14 is constructed from non-metallic material, Albright's construction cannot form a magnetic shielding zone and a non-magnetic holding zone. Rather, Albright only has a non-magnetic zone.

Accordingly, since Boer calls for a magnetic shielding zone, to modify Boer's teachings to include Albright's non-magnetic inner cylinder 14, which is incapable of creating the magnetic shielding zone required by Boer, would render Boer's apparatus completely unsatisfactory for its intended purpose and/or would change its principle of operation. Accordingly, there can be no suggestion or motivation for combining Boer with Albright.

The Examiner has thus failed, with respect to independent claims 1 and 30, and claims 2, 5, and 33, to establish a *prima facie* case for combining the references upon which the Examiner relied. Applicant, therefore, considers independent claims 1 and 30, and claims 2, 5, and 33 to be patentable over the cited art.

Claims 2-8 depend from independent claim 1 and are therefore patentable for at least the same reasons as independent claim 1. Claims 31-36 depend from independent claim 30 and are therefore patentable for at least the same reasons as claim 30.

The Examiner also rejected independent claim 9 under 35 U.S.C. §103(a) as being unpatentable over Boer and Albright, and further in view of U.S. Patent No. 4,123,676 to Cooper.

As explained above, there is no suggestion or motivation for combining Boer with Albright. Accordingly, Applicant considers independent claim 9 to also be patentable over the cited art for at least similar reasons as those provided with respect to applicant's patentable

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independent claims 1 and 30. Claims 10-19 depend from independent claim 9 and are therefore patentable over the cited art for at least the same reasons as independent claim 9.

It is believed that all the rejections and/or objections raised by the examiner have been addressed.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Please apply any charges or credits to deposit account 06-1050, referencing attorney docket 05770-170001.

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